## REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application. Claims 1-17 and 20-52 are pending in this application.

### 35 U.S.C. § 102

Claims 1-8, 11-15, 29-36, and 38-52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,496,802 to van Zoest et al. (hereinafter "van Zoest") and further in view of U.S. Patent Application Publication 2001/0051996 to Cooper et al. (hereinafter "Cooper"). Applicant respectfully submits that claims 1-8, 11-15, 29-36, and 38-52 are not obvious over van Zoest in view of Cooper.

van Zoest is directed to a system and method for providing access to electronic works (see, Title). Such electronic works may include songs, albums, movies, music videos, or a variety of other types of work (see, col. 2, lines 25-27). When a user requests access to a work, van Zoest verifies that the user is entitled to receive the desired work (see, col. 2, lines 36-40). This verification can be performed by the user demonstrating that they own a physical copy of the work or demonstrating that they ordered the requested work from a retailer or other distributor (see, col. 2, lines 40-44). Once the user adequately shows that they are authorized to receive the requested work, the user is provided with access to the work (see, col. 2, lines 45-47).

Cooper is directed to a network-based content distribution system (see, Title). In Cooper, a Copyright Registry System allows artists, copyright owners, and other content owners to register their valuable digital content (see, ¶ 94). A

consumer requests that a content file be registered (see, ¶ 98), and a Copyright Registration System website issues a new and unique digital certificate or unique message for the content file (see, ¶ 100). The Copyright Registry System website also watermarks each content file with a serial number or message for each new and unique digital certificate issued (see, ¶ 101). The watermarked copy of the user's content can be distributed over a network, and the digital certificate or message is generated to prove the authenticity of the person who filed with the Copyright Registry (see, ¶¶ 119-120). A player of content can check the Content Registry system to see if an identical digital certificate is being played by another player device (see, ¶ 124). If there is no match (no identical digital certificate in the Content Registry system), then the content file plays normally (see, ¶ 124).

With respect to claim 1, claim 1 recites

> A system comprising:
> a source database storing a plurality of highly compressed content pieces; and
> a content player, coupled to the source database, including,
> an interface to receive a subset of the plurality of highly compressed content pieces from the source database,
> a storage device to store the subset,
> a comparator to compare the subset to content and determine whether the content matches any of the plurality of highly compressed content pieces in the subset,
> a resolver to take particular action in response to the comparator indicating the content matches one of the plurality of highly compressed content pieces in the subset, and
> an output controller to render the content if the comparator indicates the content does not match any of the highly compressed content pieces in the subset.

Applicant respectfully submits that no such system is disclosed by van Zoest and Cooper.

In the September 20, 2005 Office Action at p. 4, it was asserted that van Zoest at col. 5, paragraph 3, lines 1-6 and 12-15 discloses the resolver of claim 1. The cited portion of van Zoest reads:

> Verification Server 141 verifies that the user is authorized to access an electronic work. The Verification Server 141 may perform a variety of tests or comparison to determine whether a user is authorized to access a work, such as, test a confirmation number, verify that the user possesses a physical work, or verify that the user purchased the work. . . . Based on this comparison, the Verification Server 141 may determine whether the user claiming possession of the physical work does, in fact, have possession and therefore is authorized to access an electronic work.

Thus, this cited portion of van Zoest discusses determination of whether the user is authorized to access a work, with one such test for making the determination being verifying that the user possesses the physical work. As discussed in col. 5, paragraph 3, lines 19-25, accessing an electronic work includes obtaining access to listed to an electronic work or any other means of allowing a user to listen or watch the work. Thus, van Zoest discusses that, in response to the determination that the user is authorized to access a work (using the language of claim 1, this determination would be an indication that the content matches one of the plurality of highly compressed content pieces in the subset), the user is allowed to listen or watch the work.

Also in the September 20, 2005 Office Action at p. 4, it is acknowledged that van Zoest does not disclose the output controller of claim 1, but Cooper at paragraph 124 is relied on as disclosing the output controller of claim 1. This cited portion of Cooper reads:

> With a Content Registry system 234, a player of content may check the registry to see if an identical digital certificate is being played by another player device. This may be achieved by

> communicating with the Copyright Registry 234 on-line using a network 116, for example the Internet, an Intranet, or other network. Certain in-use switches may be set to indicate that a user is currently using a particular content file. Following is an example of this. A software program that has been previously registered with the Copyright Registry 234 is initiated by an end user. During the program initialization process, the Copyright Registry 234 is checked to see if someone else is using the same software program with the same digital certificate. If so, then piracy has been detected and the author or publisher may decide how best to communicate an appropriate message to the parties using the software. If a no match condition is found, the content file plays normally. When the content file reaches its end, then the Copyright Registry 234 may be updated to indicate that the content file and the digital certificate for that content file are no longer being played. An in-use switch will be set back to False, Null, Zero, or other value that indicates the content is no longer being played.

Thus, it can be seen that Cooper discusses checking to see if someone else is using the same software program with the same digital certificate, and if a no match condition is found, the content file plays normally. Thus, assuming for the sake of argument that Cooper discloses the output controller as recited in claim 1 (as asserted in the September 20, 2005 Office Action), then Cooper would disclose to render the content if the comparator indicates the content does not match any of the highly compressed content pieces in the subset. And, as discussed above, van Zoest discusses that, in response to the determination that the user is authorized to access a work (using the language of claim 1, this determination would be an indication that the content matches one of the plurality of highly compressed content pieces in the subset), the user is allowed to listen or watch the work. Thus, if Cooper and van Zoest were to be combined, the result would be allowing rendering of the content if the content matches one of the plurality of highly compressed content pieces in the subset (per van Zoest), and allowing rendering of the content if the content does not match any of the highly compressed content

pieces in the subset (per Cooper). It can thus be seen that the combination of van Zoest and Cooper would result in always allowing the content to be rendered, regardless of whether the content matches one of the plurality of highly compressed content pieces.

Such a result, however, contradicts both van Zoest and Cooper. If the rendering of the content of Cooper were allowed if the content matches one of the plurality of highly compressed content pieces in the subset, then it would negate any benefits of Cooper in allowing rendering of the content only if the content does not match any of the highly compressed content pieces in the subset. Similarly, if the rendering of the content of van Zoest were allowed if the content does not match any of the highly compressed content pieces in the subset, then it would negate any benefits of van Zoest in allowing rendering of the content only if the content matches one of the plurality of highly compressed content pieces in the subset.

Per MPEP §2143.01, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As discussed above, combining van Zoest and Cooper would change the principle of operation of both van Zoest and Cooper because the combination would negate the benefits asserted by each. As such, Applicant respectfully submits that claim 1 cannot be disclosed or suggested by van Zoest and Cooper.

Furthermore, per MPEP §2145 X.D.2, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d

731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). The references teach away from their combination because, as discussed above, the combination of van Zoest and Cooper would negate the benefits asserted by each. As such, Applicant respectfully submits that claim 1 cannot be disclosed or suggested by van Zoest and Cooper.

Accordingly, for at least these reasons, Applicant respectfully submits that claim 1 is allowable over van Zoest in view of Cooper.

With respect to claims 2-8 and 11-15, given that claims 2-8 and 11-15 depend from claim 1, Applicant respectfully submits that claims 2-8 and 11-15 are likewise allowable over van Zoest in view of Cooper for at least the reasons discussed above with respect to claim 1.

With respect to claim 29, Applicant respectfully submits that, similar to the discussion above regarding claim 1, van Zoest in view of Cooper does not disclose or suggest taking a programmed action if the portion of media content matches any of the set of highly compressed pieces, and playing back the content if the determining indicates the portion of media content does not match any of the set of highly compressed pieces as recited in claim 29. Accordingly, for at least these reasons, Applicant respectfully submits that claim 29 is allowable over van Zoest in view of Cooper.

With respect to claims 30-36 and 38-39, given that claims 30-36 and 38-39 depend from claim 29, Applicant respectfully submits that claims 30-36 and 38-39 are likewise allowable over van Zoest in view of Cooper for at least the reasons discussed above with respect to claim 29.

With respect to claim 40, Applicant respectfully submits that, similar to the discussion above regarding claim 1, van Zoest in view of Cooper does not disclose or suggest taking a programmed action if the portion of media content matches any of the set of highly compressed pieces, and rendering the content if the determining indicates the portion of media content does not match any of the set of highly compressed pieces as recited in claim 40. Accordingly, for at least these reasons, Applicant respectfully submits that claim 40 is allowable over van Zoest in view of Cooper.

With respect to claim 41, Applicant respectfully submits that, similar to the discussion above regarding claim 1, van Zoest in view of Cooper does not disclose or suggest means for taking a particular action if the portion of media content matches any of the set of highly compressed content pieces, and means for playing back the content if the determining indicates the portion of media content does not match any of the set of highly compressed pieces as recited in claim 41. Accordingly, for at least these reasons, Applicant respectfully submits that claim 41 is allowable over van Zoest in view of Cooper.

With respect to claims 42-45, given that claims 42-45 depend from claim 41, Applicant respectfully submits that claims 42-45 are likewise allowable over van Zoest in view of Cooper for at least the reasons discussed above with respect to claim 41.

With respect to claim 46, Applicant respectfully submits that, similar to the discussion above regarding claim 1, van Zoest in view of Cooper does not disclose or suggest allowing the portion of media content to be played back if the portion of media content does not match the piece of highly compressed content, and

taking a particular action if the portion of media content does match the piece of highly compressed content as recited in claim 46. Accordingly, for at least these reasons, Applicant respectfully submits that claim 46 is allowable over van Zoest in view of Cooper.

With respect to claims 47-52, given that claims 47-52 depend from claim 46, Applicant respectfully submits that claims 47-52 are likewise allowable over van Zoest in view of Cooper for at least the reasons discussed above with respect to claim 46.

Claims 9-10, 16-17, 20-28, and 37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over van Zoest et al. and further in view of U.S. Patent No. 6,766,305 to Fucarile et al. (hereinafter "Fucarile"). Applicant respectfully submits that claims 9-10, 16-17, 20-28, and 37 are not obvious over van Zoest in view of Fucarile.

Fucarile is directed to systems and methods for embedded licensing in a distributed computer environment (see, col. 1, lines 8-9). Fucarile includes a plug-in or application running on a user computer (see, col. 3, lines 34-35). The plug-in is adapted to access content on a content server (see, col. 3, lines 35-36). The content includes a special licensing form and the plug-in is further adapted to scan the content for such licensing form (see, col. 3, lines 36-38). Depending on the information in the licensing form, the plug-in determines if the license governing the content is an implicit or explicit license (see, col. 3, lines 39-41). If the license is valid, the content is processed (see, col. 3, lines 44-45).

Applicant respectfully submits that it would not have been obvious to one of ordinary skill in the art to combine van Zoest and Fucarile. As discussed above,

when a user requests access to an electronic work, van Zoest verifies that the user is entitled to receive the desired electronic work (see, col. 2, lines 36-40). Once the user adequately shows that they are authorized to receive the requested electronic work, the user is provided with access to the electronic work (see, col. 2, lines 45-47). A variety of tests or comparisons may be performed to determine whether a user is authorized to access an electronic work, such as test a confirmation number, verify that the user possesses a physical work, or verify that the user purchased the work (see, col. 5, lines 22-26).

In the September 20, 2005 Office Action at p. 3, it was asserted that Fucarile at col. 3, lines 8-45 "teaches that mere possession of content is not enough to authorize access to the content and provides a means utilizing the checking and validation of licenses in the content". However, the content that is discussed in Fucarile is content that is received from a server over a network (see, for example, col. 6, lines 23-25, col. 8, lines 62-67, and col. 9, lines 30-35). This content of Fucarile is thus analogous to the electronic work of van Zoest. van Zoest does not discuss that mere possession of the electronic work is enough to authorize access to the electronic work; rather, verification that the user possesses the physical work (e.g., the physical CD (see, van Zoest at col. 1, lines 61-64)) or some other verification is needed in van Zoest in order to access the electronic work. The license mechanism of Fucarile, then, is at best another mechanism by which the verification of van Zoest could be performed. The license mechanism of Fucarile is not another action that would be performed in addition to the verification performed by van Zoest, since it would simply be verification of something that was already verified by van Zoest.

Applicant respectfully submits that there is no suggestion or motivation to combine van Zoest and Fucarile, and thus that no *prima facie* case of obviousness has been established. One of ordinary skill in the art would not have been motivated to use the techniques of Fucarile to perform a verification that had already been performed by van Zoest. As there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to use the techniques of Fucarile to perform a verification that had already been performed by van Zoest, Applicant respectfully submits that it would not have been obvious to combine van Zoest and Fucarile.

As discussed in MPEP §2143.01, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Accordingly, Applicant respectfully submits that the mere fact that van Zoest and Fucarile can be combined does not render the resultant combination obvious because the prior art does not suggest the desirability of the combination.

Furthermore, assuming for the sake of argument that van Zoest and Fucarile were combined, Applicant respectfully submits that the combination of van Zoest and Fucarile does not disclose or suggest the system of claim 9. Claim 9 recites:

> A system comprising:
> a source database storing a plurality of highly compressed content pieces; and
> a content player, coupled to the source database, including,
> an interface to receive a subset of the plurality of highly compressed content pieces from the source database,
> a storage device to store the subset,
> a comparator to compare the subset to content and determine whether the content matches any of the plurality of highly compressed content pieces in the subset, and

> a resolver to take particular action in response to the comparator indicating the content matches one of the plurality of highly compressed content pieces in the subset,
>
> wherein the storage device is further to store a plurality of licenses identifying content that a user of the content player is authorized to playback, and wherein the particular action comprises the resolver checking whether one of the plurality of licenses corresponds to the content.

Applicant respectfully submits that no such system is disclosed or suggested by van Zoest in view of Fucarile.

As can be seen in claim 9, the content player includes a comparator to compare the subset to content and determine whether the content matches any of the plurality of highly compressed content pieces in the subset, and a resolver to take particular action in response to the comparator indicating the content matches one of the plurality of highly compressed content pieces in the subset. This particular action in claim 9 comprises the resolver checking whether one of the plurality of licenses corresponds to the content.

In the September 20, 2005 Office Action at p. 8, it is acknowledged that van Zoest does not disclose wherein the storage device is further to store a plurality of licenses identifying content that a user of the content player is authorized to playback, and wherein the particular action comprises the resolver checking whether one of the plurality of licenses corresponds to the content, but that this element is disclosed by Fucarile.

However, as discussed above, in van Zoest once the user adequately shows that they are authorized to receive the requested work, the user is provided with access to the work (see, col. 2, lines 45-47). This verification can be performed by the user demonstrating that they own a physical copy of the work or demonstrating that they ordered the requested work from a retailer or other distributor (see, col.

2, lines 40-44). Possession of the physical work in van Zoest (not mere possession of the electronic work) or some other verification is needed in van Zoest. After the user in van Zoest has adequately shown that they are authorized to receive the requested electronic work by passing some verification that extends beyond merely having a copy of the electronic work, it would have been nonsensical for a check to then be made as to whether one of a plurality of licenses corresponds to the content. Such a check would simply verify what has already been verified by some other means.

In the September 20, 2005 Office Action at p. 3, it was asserted that "it would not have been nonsensical to check for a valid license once it was determined in van Zoest that the user possessed the content". Applicant respectfully disagrees and submits that it would have been nonsensical to check for a valid license once it was determined in van Zoest that the user was authorized to access the electronic work. The possession of the physical work in van Zoest authorizes the user to access the electronic work – there is no discussion or mention in either van Zoest or Fucarile of needing any additional authorization beyond such possession of the physical work. Authorization to access the electronic work in van Zoest is verified by the presence of the physical work. Embedding a license of Fucarile in the electronic work in van Zoest would not be needed in combination with verifying the presence of the physical work in van Zoest because both would serve the same function – to verify authorization to access the electronic work. As such, Applicant respectfully submits that it would have been nonsensical to check for a valid license in van Zoest to determine

whether a user is authorized to access the electronic work after it was already determined that the user was authorized to access the electronic work.

Accordingly, for at least these reasons, Applicant respectfully submits that claim 9 is allowable over van Zoest in view of Fucarile.

With respect to claim 10, given that claim 10 depends from claim 9, Applicant respectfully submits that claim 10 is likewise allowable over van Zoest in view of Fucarile for at least the reasons discussed above with respect to claim 9.

With respect to claim 16, Applicant respectfully submits that it would not have been obvious to combine van Zoest and Fucarile as discussed above. Furthermore, Applicant respectfully submits that, similar to the discussion above regarding claim 9, van Zoest in view of Fucarile does not disclose or suggest a resolver, coupled to the comparator, to take a particular action in response to the comparator indicating the content matches one of the plurality of highly compressed content pieces in the subset, wherein the particular action comprises checking to see whether the system has a valid license for the content as recited in claim 16. Accordingly, for at least these reasons, Applicant respectfully submits that claim 16 is allowable over van Zoest in view of Fucarile.

With respect to claims 17 and 20-28, given that claims 17 and 20-28 depend from claim 16, Applicant respectfully submits that claim 17 and 20-28 are likewise allowable over van Zoest in view of Fucarile for at least the reasons discussed above with respect to claim 16.

With respect to claim 37, Applicant respectfully submits that it would not have been obvious to combine van Zoest and Fucarile as discussed above. Furthermore, Applicant respectfully submits that, similar to the discussion above

regarding claim 9, van Zoest in view of Fucarile does not disclose or suggest taking a programmed action if the portion of media content matches any of the set of highly compressed pieces, wherein the programmed action comprises checking whether one of a plurality of licenses maintained at a content player performing the comparing corresponds to the portion of media content as recited in claim 37. Accordingly, for at least these reasons, Applicant respectfully submits that claim 37 is allowable over van Zoest in view of Fucarile.

Applicant respectfully requests that the §103 rejections be withdrawn.

**Conclusion**

Claims 1-17 and 20-52 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

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